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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,284	02/09/2004	Guillaume Mathieu	24884	8735
7055	7590	10/13/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C.			STASHICK, ANTHONY D	
1950 ROLAND CLARKE PLACE			ART UNIT	
RESTON, VA 20191			PAPER NUMBER	

3728

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/773,284

Applicant(s)

MATHIEU ET AL.

Examiner

Anthony Stashick

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>05122004</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear whether claim 5 is a complete claim or not. The phrase "the elastically deformable element comprises on at least one medial..." make the claim vague and indefinite. It is not clear what is on the claimed sides.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Shin et al. 5,975,861. Shin et al. '861 discloses all the limitations of the claims including the following: an upper (see Figure 2); an outer bottom assembly (see Figure 1); the outer bottom assembly comprising an outsole 30; an elastically deformable element 11 being substantially arch-shaped in transverse direction extending downward from a lower end of the upper to medial and lateral edges, respectively, of the outsole (see Figures 1-3); the elastically deformable element being located in a heel zone of the article of footwear (see Figure 2); the elastically deformable element

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includes an upper end (top of arch-shaped portion) with a substantially planar zone (see Figure 1); the planar zone has a width of about 15-20 millimeters (see Figure 1); the elastically deformable element comprises at least one medial arm (that located on the medial side of the shoe forming arch-shaped portion) and at least one lateral arm (that portion located on the lateral side of the shoe forming arch-shaped portion); a layer of shock-absorbing material 20 is positioned between the elastically deformable element and the outsole (see Figure 3); the layer of shock-absorbing material comprises at least one recess (located atop of spring, see Figure 3, nub from layer 12 located within the recess) between the layer and the elastically deformable element; the elastically deformable element is fixed to the upper via a connecting member (aforementioned nub).

5. Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang 4,918,838. Chang '838 discloses all the limitations of the claims including the following: an upper (see Figure 2, attaches sole to user's foot); an outer bottom assembly (Figure 1); the outer bottom assembly comprising an outsole 1; an elastically deformable element 2 being substantially arch-shaped (see col. 3, lines 10-15) in transverse direction (see Figures 1, 2, 4B and 5B) extending downward from a lower end of the upper to medial and lateral edges, respectively, of the outsole; the elastically deformable element being located in a heel zone (see Figure 1) of the article of footwear; the elastically deformable element includes an upper end with a substantially planar zone (see Figures 2 and 6A-6C); the planar zone has a width of about 15-20 millimeters (see Figures 2 and 6A-6C); the elastically deformable element comprises at least one medial arm and at least one lateral arm (see Figures 4B and 5B, arms extend from peak

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of arch-shaped area to medial and lateral sides of the shoe); a layer of shock-absorbing material 21 is positioned between the elastically deformable element and the outsole; the layer of shock-absorbing material comprises at least one recess 121 between the layer and the elastically deformable element; the elastically deformable element is fixed to the upper via a connecting member 4.

6. Claims 1 and 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Preman et al. 5,224,280. Preman et al. '280 discloses all the limitations of the claims including the following: an upper 33; an outer bottom assembly 1; the outer bottom assembly comprising an outsole 2; an elastically deformable element 3 being substantially arch-shaped in transverse direction (see Figures 3-5) extending downward from a lower end of the upper to medial and lateral edges, respectively, of the outsole (see Figure 3); the elastically deformable element being located in a heel zone of the article of footwear (see Figures 1-3); the elastically deformable element includes an upper end (arched portion) with a substantially planar zone (with 22 located therein); the planar zone has a width of about 15-20 millimeters (see Figures 4 and 5); the elastically deformable element comprises at least one medial arm 14 and at least one lateral arm (14 on other opposite side of element); a layer of shock-absorbing material 4 is positioned between the elastically deformable element and the outsole; the layer of shock-absorbing material comprises at least one recess 22 between the layer and the elastically deformable element; the elastically deformable element is fixed to the upper via a connecting member (sides of outsole).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Preman et al. 5,224,280 as applied to claim 1 above. Preman et al. '280 discloses all the limitations of the claim except the specific Young's modulus of the HYTREL™. Since the properties of HYTREL™ are well known and, depending upon thickness of the material, it would be well within the skill of one of ordinary skill in the art to use HYTREL™ with a Young's modulus of greater than 40 Mpa to impart the desired elasticity and resiliency to the elastically deformable element. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the insert of Preman et al. '280 out of HYTREL™ with a Young's modulus greater than 40 Mpa to impart the desired elasticity and resiliency for support of the users foot during use.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

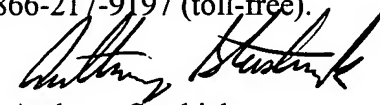
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561.

The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS